

Appl. Ser. No. 10/634,584

Att. Docket No. 10746/37

Reply to Office Action of October 15, 2004

REMARKS

Claims 61, 64, 67 and 70 are canceled without prejudice, and therefore claims 62, 63, 65, 66, 68, 69, 71 and 72 are now pending.

Applicants respectfully request reconsideration of the present application in view of this response.

Applicants thank the Examiner for accepting the Drawings, for acknowledging the claim for foreign priority and receipt of certified copies of the priority documents, and for considering the Information Disclosure Statements and related PTO-1449 papers and references filed on July 28, 2004 and August 4, 2003 in the parent case, U.S. Pat. App. Ser. No. 09/386,993.

With respect to paragraph five (5) of the Office Action, Applicants thank the Examiner for indicating that claims 62, 63, 65, 66, 68, 69, 71 and 72 contain allowable subject matter. While the underlying anticipation rejections may not be agreed with, to facilitate matters, claims 62 and 63 have been rewritten to include the features of claim 61 (now canceled without prejudice), claims 65 and 66 have been rewritten to include the features of claim 64 (now canceled without prejudice). It is noted that claim 66 should have depended from claim 64 and not claim 61 (as provided for in the application as filed). Accordingly, the features of claim 64 and not claim 61 were included in claim 66. Also, claims 68 and 69 were rewritten to include the features of claim 67 (now canceled without prejudice), and claims 71 and 72 were rewritten to include the features of claim 70 (now canceled without prejudice). It is therefore respectfully requested that the objections be withdrawn, since claims 62, 63, 65, 66, 68, 69, 71 and 72 as presented are allowable.

With respect to paragraph four (4), claims 61, 64, 67 and 70 were rejected under 35 U.S.C. § 102(e) as anticipated by Tewfik et al., U.S. Patent No. 6,571,337.

It is first noted that “Tewfik” may not be prior art, since the present application may be entitled to an effective filing date of one of the Japanese priority applications, namely 10-251193 (which was filed September 4, 1998).

As regards the anticipation rejection of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary

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skill in the art to practice the claimed subject matter, as discussed herein. (See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)). In particular, it is respectfully submitted that, at least for the reasons discussed herein, the reference relied upon would not enable a person having ordinary skill in the art to practice the subject matter of the claims as presented.

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’l. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine must fail absent the foregoing conditions.

Accordingly, while the rejections may not be agreed with, to facilitate matters, claims 61, 64, 67 and 70 have been canceled without prejudice, and it is therefore respectfully requested that the anticipation rejections be withdrawn

In summary, it is respectfully submitted that all of claims 62, 63, 65, 66, 68, 69, 71 and 72 of the present application are allowable at least for the foregoing reasons.

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CONCLUSION

In view of the foregoing, it is believed that the objections and rejections have been obviated, and that claims 62, 63, 65, 66, 68, 69, 71 and 72 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, and that the present application issue as early as possible.

Respectfully submitted,

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